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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,439	09/23/2003	Gaetan Martel	4223-53us PAN/df	3278
20988	7590	03/28/2005	EXAMINER	
OGILVY RENAULT 1981 MCGILL COLLEGE AVENUE SUITE 1600 MONTREAL, QC H3A2Y3 CANADA			AHMAD, NASSER	
			ART UNIT	PAPER NUMBER
			1772	
DATE MAILED: 03/28/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/667,439

Applicant(s)

MARTEL, GAETAN

Examiner

Nasser Ahmad

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 13-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 17-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/10/03</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-12 and 17-19, drawn to a device and a kit therefor, classified in class 428, subclass 40.1.
  - II. Claims 13-16, drawn to a method for concealing a caulking joint, classified in class 52, subclass 741.4.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used in a materially different process such as placing and adhering the two flaps simultaneously, instead of sequentially as claimed. Alternatively, the product can be used for insulating a pipe/tube.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Pierre Nguyen, Registration # 55043 on March 16, 2005 a provisional election was made with traverse to prosecute the

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invention of Group I, claims 1-12 and 17-19. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3, 6-8 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Krabill (5658632).

Krabill relates to a device (10) comprising an elongated flexible central strip (20) having a first and second edges (21 and 22), and first and second sides (23 and 24). A first flap (28) longitudinally connected to the elongated central strip along the first edge and a second flap (28) longitudinally connected to the elongated central strip along the second edge.

The intended use phrase such as “for concealing”, etc. have not been given patentable weight because it does not constitute a positive limitation.

The recitation “adapted to” has been held to perform a function that is not a positive limitation but only requires the ability to so perform and does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

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The functional “whereby” statement does not define any structure and accordingly cannot serve to distinguish. *In re Mason*, 114USPQ 127, 44 CCPA 937 (1957).

Further, the longitudinal connection of the two flaps to the edges of the central strip are flexible hinges (26 and 27). The central strip is transversely convex with respect to the second side of the central strip such that the first side form a concavity (figure-4) and the first side of each of the flaps is covered with adhesive strips (figure-4).

7. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Tucker (5045374).

Tucker relates to a device (10) comprising an elongated central strip (14), first and second flaps (16 and 18) connected to a longitudinal edge of the central strip. Figure-3 shows that the edges of the flaps are tapered and the hinges (52 and 50) are flexible. The flaps can be more flexible (when the flaps are tapered) compared to the central strip or less flexible (when the flaps are not tapered). Figure-1 shows a side of the central strip with a concave transversely and the flaps are provided with adhesive strips covered with release liners (col. 5, lines 58-65).

Regarding the intended use phrase, the recitation of “adapted to” and the functional “whereby” statement, the explanation provided in the preceeding paragraph applies herein *a fortiori*.

8. Claims 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Zellinger (4837997).

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Zellinger relates to a kit for concealing a pair of intersecting joints between adjacent surfaces (figure-10) and comprises a device and a cutting template. The device (20) comprises an elongated body adapted to have parts of a first side of the body is adhesively (36) connected to surfaces defining a joint in a watertight manner such that a central strip of the body encloses the joint. The device being adapted to be transversely cut into segments in order to conform with lengths of the joint. The cutting template (62) provides for shaping ends of a pair of segments (20 and 22) of the device in order to obtain complementary ends between the pair of segments meeting at a pair of intersecting joints so as to conceal the pair of intersecting joints. See figure-2.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Nasser Ahmad  
Primary Examiner  
Art Unit 1772

N. Ahmad.  
March 20, 2005.